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In re Application of CRUDO et al :
U.S. Application No.: 10/531,628 :
PCT Application No.: PCT/US2003/033386 : DECISION
Int. Filing Date: 21 October 2003 :
Priority Date Claimed: 21 October 2002 :
Attorney Docket No.: 017673-9042-01 (235128) :
For: STANDARDIZED BINDING ELEMENTS :

This is in response to applicant's "Petition to Revive Unintentionally Abandoned Application Under 37 C.F.R. § 1.137(b)" and "Petition for Filing When an Inventor Refuses to Sign or Cannot be Reached Under 37 C.F.R. §1.47(a)" filed 18 December 2006.

BACKGROUND

On 21 October 2003, applicant filed international application PCT/US2003/033386, which claimed priority of an earlier United States application filed 21 October 2002. The thirty-month period for paying the basic national fee in the United States expired on 21 April 2005.

On 14 April 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 26 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

International application PCT/US2003/033386 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 18 December 2006, applicant filed the present petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a).

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), although the submission of an executed declaration along with a grantable petition under 37 CFR 1.47(a) would be a proper reply to the Notification of Missing Requirements, the present petition under 37 CFR 1.47(a) is dismissed for the reasons set forth below.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

II. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declaration filed with the petition is an improper composite declaration. Where multiple declarations are executed, copies of the full declarations must be furnished, rather than combining pages of separate declarations into a single document.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part

of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventor Jason Magid cannot be located. The petition sufficiently illustrates that a diligent effort was made to reach Magid. In particular, the affidavit of Julie Freeman, i.e. the person with apparent firsthand knowledge of attempts to find Magid, specifies that applicant unsuccessfully tried to contact Magid by postal mail, by telephone, through his former employer and co-workers, and by asking the other inventors. Thus, it can be concluded with reasonable certainty that Magid cannot be found after diligent effort.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

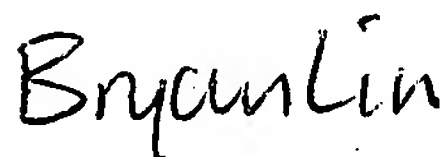
CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.137(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petitions is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.137(b) and 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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